88-692

Supreme Court, U.S.
FILED
OCT 26 1988
JOSEPH F. SPANIOL, JR.
CLERK

NO. _____

IN THE
SUPREME COURT OF THE UNITED STATES

TERM COMMENCING OCTOBER 3, 1988

ROGER TEETER AND JENNIFER TEETER
D/B/A SKY'S THE LIMIT,
PETITIONER.

VS.

GRAVITY GUIDANCE, INC.,
RESPONDENT.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Robert W. Beach
3107 Eastlake Avenue East
Seattle, Washington 98102
(206) 325-6789
Attorney for Petitioner

Of Counsel:

Ward Brown
3107 Eastlake Avenue East
Seattle, Washington 98102
(206) 325-6789

QUESTIONS PRESENTED

The questions presented for review are:

1. Was it permissible for the United States District Court for the Western District of Washington in ruling on a motion for summary judgment and the Court of Appeals for the Federal Circuit on appeal from that ruling to disregard consideration of the issue of obviousness under Rule 35 U.S.C. § 103 in holding that the patent was valid?

2. Was it permissible for the District Court for the Western District of Washington on a motion for summary judgment by Teeter on the ground of patent invalidity and the Court of Appeals for the Federal

Circuit on appeal from the ruling on that motion to disregard the claims in the patent in holding the patent to be valid?

3. Was it proper for the Court of Appeals for the Federal Circuit to not consider the prior art of record with reference to claim 1 of the Martin patent when all of the evidence in the case was documentary in the form of prior U.S. patents and there was no testimony despite the ruling of the U.S. Supreme Court in Dennison Manufacturing Company v. Panduit Corp., 106 US 1578, 229 USPQ 478 (Sup. Ct. 1986)?

TABLE OF CONTENTS

	PAGE
QUESTIONS PRESENTED	i
TABLE OF CONTENTS	iii
TABLE OF AUTHORITIES	vi
OPINIONS BELOW	1
GROUNDS FOR JURISDICTION	3
JURISDICTION	3
CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED . .	3
U.S. Constitution, Article 1, Section 8	3
U.S. Constitution, Amendment V	4
35 U.S.C. § 103	4
35 U.S.C. § 112 - portion thereof	5
Federal Rules of Civil Procedure 52(a) - portion thereof	5
STATEMENT OF THE CASE	6
ARGUMENT	15
Obviousness	15

Claims 20

Court's Interpretation of Prior Art 24

The Lindemann Decision . . . 28

Obviousness is a Matter of Law 30

CONCLUSION 31

APPENDIX NO. 1

APPENDIX A:
Order of the United States District Court for the Western District of Washington on motions for summary judgment dated June 10, 1986 in Civil suit No. C83-824T. 1a

APPENDIX B:
Decision of the Court of Appeals for the Federal Circuit decided July 1, 1988 in appeal No. 88-1174. . . . . 4a

APPENDIX C:
Dissenting opinion of decision of the Court of Appeals for the Federal Circuit decided July 1, 1988 in appeal No. 88-1174 . . . . . 7a

APPENDIX D:
Denial of Petition for Rehearing by the Court of Appeals for the Federal Circuit dated July 28, 1988 . . 18a

APPENDIX E:
Denial of Suggestion for Rehearing in Banc dated August 11, 1988 . . . . . 20a

APPENDIX NO. 2 (BOUND SEPARATELY)

APPENDIX F:
Martin U.S. patent No. 3,380,447 . . . . . 1AP

APPENDIX G:
Daniels et al. U.S. patent No. 1,693,810 . . . . . 4AP

APPENDIX H:
Gibson U.S. patent No. 2,209,310 . . . . . .10AP

TABLE OF AUTHORITIES

CASES PAGE

Dennison Manufacturing Company v. Panduit Corp., 106 US 1578, 229 USPQ 478 (Sup. Ct. 1986) . . . . . ii, 27

In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988) 30

Graham v. John Deere Co. of Kansas City et al., 383 US 1, 148 USPQ 459 (Sup. Ct. 1966) . . 16, 17, 18, 32

Kimberly-Clark Corporation v. Johnson & Johnson and Personal Products Company, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984). 24, 32

Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984) 27, 28, 29

Nasco Incorporated v. Vision-Wrap, Inc., 352 F.2d 905, 147 USPQ 297 (7th Cir. 1965) 26

Novicky v. Syntex Opthalmics,
225 USPQ 792
(Sup. Ct. 792) 32

Sjolund v. Musland,
6 USPQ2d 2020
(Fed. Cir. 1988) . . 21, 22, 23, 32

The Taylor-Reed
Corporation v. Mennen
Food Products, Inc., et al.,
324 F.2d 108,
139 USPQ 143
(7th Cir. 1963) 25

U.S. CONSTITUTION

Article 1, Section 8 3

Amendment V 4

STATUTES

28 U.S.C. § 1254(1) 3

28 U.S.C. § 1400(b) 6

35 U.S.C. § 102 . . . . . 14, 28

35 U.S.C. § 103 . . . . . i, 4
14, 16, 18, 28, 31

35 U.S.C. § 112 . . . . . 5, 21

RULES

Federal Rules of
Civil Procedure 52(a) . . 5, 27, 28

IN THE
SUPREME COURT OF THE UNITED STATES

TERM COMMENCING OCTOBER 3, 1988

ROGER TEETER AND JENNIFER TEETER
D/B/A SKY'S THE LIMIT,
PETITIONER.

VS.

GRAVITY GUIDANCE, INC.,
RESPONDENT.

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

OPINIONS BELOW

Copies of the opinions below are attached in APPENDIX NO. 1 to this petition as follows:

1. Order of the United States District Court for the Western District of Washington on motions for

summary judgment dated June 10, 1986 (APPENDIX A);

2. Decision of the Court of Appeals for the Federal Circuit decided July 1, 1988 (APPENDIX B and APPENDIX C);

3. Denial of Petition for Rehearing by the Court of Appeals for the Federal Circuit dated July 28, 1988 (APPENDIX D);

4. Denial of Suggestion for Rehearing in Banc dated August 11, 1988 (APPENDIX E).

GROUNDS FOR JURISDICTION

1. The date of the decision by the U.S. Court of Appeals for the Federal Circuit sought to be reviewed and the time of its entry is July 1, 1988.

2. The date of the order denying a rehearing was July 28, 1988.

JURISDICTION

The jurisdiction of the Supreme Court is based on 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

U.S. Constitution,
Article 1, Section 8

> To promote the Progress of . . . useful Arts, by securing for limited Times to . . .

> Inventors the exclusive Right to their . . . Discoveries . . . .

U.S. Constitution, Amendment V

> No person shall . . . be deprived of life, liberty or property, without due process of law . . . .

35 U.S.C. § 103

> **Conditions for patentability; non-obvious subject matter**
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. § 112 - portion thereof

> **Specification**
>
> . . . .
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Federal Rules of Civil Procedure 52(a) - portion thereof

> (a) **Effect.** . . . Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. . . . Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b).

STATEMENT OF THE CASE

The suit for infringement of U.S. patent No. 3,380,447 of Robert M. Martin (APPENDIX F) was instituted by Gravity Guidance, Inc. ("Gravity Guidance") against Roger Teeter and Jennifer Teeter, d/b/a Sky's The Limit ("Teeter") in United States District Court for the Western District of Washington No. C83-824T. The basis for jurisdiction of the District Court was 28 U.S.C. § 1400(b).

The patent application resulting in the Martin patent was filed on October 19, 1965. It relates to an ankle holding device that was stated to be used for supporting an individual in an inverted position and was sometimes known as an inversion

boot. The boot consisted of two rigid, substantially semicylindrical jaws connected by a hinge which jaws could be swung together around the user's leg and secured in position by a latch. One of the jaws had a hook on it opening upward that could be hooked over a bar for enabling the user to hang head down. The purpose of such hanging was to:

1. lengthen the body,

2. separate the spaces between the vertebrae of the spine;

3. aid in eliminating sagging of the internal abdominal organs;

4. decompress the body;

5. aid circulatory exchange; and

6. readjust the lines of stress upon the body.

The leg holder manufactured and sold by by Teeter differed from the boot disclosed in the Martin patent by having two curved flexible pieces of plastic instead of rigid jaws, which plastic pieces were rigidly connected by a metal connector instead of by a hinge. The pieces of plastic could be flexed away from each other as in old-fashioned puttees to provide an opening to receive the leg and then the edges of the pieces of plastic were overlapped and fastened together by adjustable length fasteners. A hook was carried by the metal connector.

During the presentation of the case to the District Court and on appeal, Gravity Guidance relied on

only claim 1 of the patent as being infringed, which claim is as follows:

> 1. In a device of the class described,
>
> an inversion boot adapted for attachment to a person's leg including a first jaw member having opposite ends and a second jaw member having opposite ends,
>
> said first jaw member hingedly secured at one of its ends to one end of said second jaw member,
>
> means detachably securing said other end of said first jaw member to said other end of said second jaw member,
>
> and a hook means secured to one of said first and second jaw members.

It will be noted that this claim only relates to an inversion boot for attachment to a person's leg and does not specify its use environment. The claim specifies <u>two</u> jaws <u>connected by a hinge</u> which Teeter's leg holders do not have.

In the District Court action, Gravity Guidance brought a motion for summary judgment on the ground that Teeter's boots infringed the patent and Teeter brought a motion for summary judgment on the ground that the patent was invalid over several prior United States patents, the most pertinent ones being Daniels et al. U.S. patent No. 1,693,810, issued December 4, 1928, (APPENDIX G) and Gibson U.S. patent No. 2,209,310, issued July 30, 1940 (APPENDIX H).

The Daniels et al. patent disclosed a table having ankle-gripping clamps that could be swung to place the patient lying on the table in a head-down position to aid in restoring misplaced organs to proper

position and relieve pressure of such misplaced organs.

The Gibson patent disclosed leg-holding devices having hooks for tensioning the user's legs which were shown as being used on a therapeutic table for stretching the patient to reduce the pressure on the nerves which branch out between various vertebrae of the spinal column. The leg straps or clamps of the Gibson patent are much more similar to the leg holders of Teeter than either the Gibson or Teeter leg holders are to the boots disclosed in the Martin patent.

A most important consideration is that claim 1 of the Martin patent quoted above relates only to ankle holders used to hold the legs in

effecting a body-stretching operation and the Gibson patent discloses leg holders used for precisely the same purpose.

On June 10, 1986, the District Court entered an order (APPENDIX A) stating in part:

> 2. Defendants did not literally infringe upon Plaintiff's patent rights.
> 3. Under the Doctrine of Equivalents, Defendants infringed upon the patent rights of Plaintiff.
> . . . .
> 5. The patent rights asserted by Plaintiff are valid.

From that order Teeter appealed to the Court of Appeals for the Federal Circuit which entered a decision by two judges of a three-judge panel dated July 1, 1988 (APPENDIX B) stating in part:

OPINION

> . . . Teeter's primary argument on appeal is that the claimed invention is anticipated by the 2,209,310 (Gibson) patent. But a patent is presumed valid, see 35 U.S.C. § 282, and when Martin is construed in light of the specification it is clear that there are significant differences between the Gibson and Martin devices. Accordingly, the district court correctly determined that Teeter had failed to carry its burden to establish anticipation. See, e.g., Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984) (anticipation is a factual determination which is reviewed under the clearly erroneous standard).

One of the judges of the three-judge panel dissented (APPENDIX C).

A Combined Petition for Rehearing and Suggestion for Rehearing in Banc was filed, both of which were denied.

Neither the order of the District Court nor the decision of the Court of Appeals for the Federal Circuit made any reference to the statute 35 U.S.C. § 103 (supra page 4) specifying that a patent be refused if the subject matter is obvious, or gave any indication that the issue of obviousness had been considered by two judges of the Court. Only the question of novelty, that is, anticipation under 35 U.S.C. § 102 was considered by such judges. What the District Court considered is not revealed by his order of June 10, 1986 (APPENDIX A).

The third judge of the Court of Appeals for the Federal Circuit, Judge Michel, did consider the issue of obviousness and stated:

> I am not convinced, however, that the sole issue on appeal with respect to validity was anticipation. The appellants did make the basic argument that, if the courts which had previously considered the Martin patent had had Gibson before them in addition to the previously-cited prior art, the Martin patent would have been found invalid. To me this is necessarily an obviousness argument. Furthermore, in my view, Gibson, together with the previously-cited prior art, is more than enough to render the claimed invention obvious to one of ordinary skill in the art.

ARGUMENT

Obviousness

In its order (APPENDIX A) from which the appeal to the Court of Appeals for the Federal Circuit was taken, the District Court did not consider at all the question of

obviousness under 35 U.S.C. § 103, but simply stated:

> 5. The patent rights asserted by Plaintiff are valid.

In Graham v. John Deere Co. of Kansas City et al., 383 US 1, 148 USPQ 459 (Sup. Ct. 1966), the Supreme Court made the following statements referring to pages in the report in 148 USPQ 459 (emphasis supplied):

Page 461, column 2:

> . . . Congress has for the first time expressly added a third statutory dimension to the two requirements of novelty and utility that had been the sole statutory test since the Patent Act of 1793. This is the test of obviousness, i.e., "whether the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the

manner in which the invention was made." Patent Act of 1952, 66 Stat. 798, 35 U.S.C. § 103 (1964 ed.)

Page 464, column 2, bottom:

The 1952 Act.

The Act sets out the conditions of patentability in three sections. An analysis of the structure of these three sections indicates that patentability is dependent upon three explicit conditions: novelty and utility as articulated and defined in § 101, and § 102, and nonobviousness, the new statutory formulation, as set out in § 103.

Page 465, column 2:

The section is cast in relatively unambiguous terms. Patentability is to depend, in addition to novelty and utility, upon the "non-obvious" nature of the "subject matter sought to be patented" . . . .

Page 466, column 1:

It is undisputed that this section was, for the first time, a statutory expression of an additional requirement for

> patentability, originally expressed in Hotchkiss.

Page 467, column 1, top:

> While the ultimate question of patent validity is one of law, A. & P. Tea Co. v. Supermarket Corp., supra, at 155, 87 USPQ at 307, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; . . . .

Thus the Supreme Court has held that consideration of "obviousness" under 35 U.S.C. § 103 is mandatory.

Neither the District Court nor the Court of Appeals for the Federal Circuit considered the issue of obviousness. On the appeal Teeter's Reply Brief, at page 2, asked that the Court of Appeals for the Federal Circuit consider the question of

obviousness as follows (emphasis supplied):

> The paramount issue is whether claim 1 of the Gravity patent is anticipated by or is obvious in view of the Gibson patent reference which was not cited by the Patent and Trademark Office against the application resulting in the Gravity patent nor was it considered by any of the courts in which infringement suits for infringement of the Gravity patent were brought.

and at the middle of page 12:

> . . . throughout this case Teeter has argued that as a matter of law the prior art, including the Gibson patent, anticipate claim 1 of the Gravity patent or claim 1 is obvious over that patent . . . . As this Court stated in Gardner v. TEC Systems, Inc., et al., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), at USPQ 782, column 2 (emphasis supplied):
>
> > A conclusion on obviousness is one of law and subject to full and independent review in this court. Sarkisian v. Winn-Proof Corp., 688 F.2d 647,

> 651 (9th Circ. 182). Our task is thus to consider the facts, either as properly found by the factfinder below or as stipulated to or otherwise uncontested by the parties, and reach our own conclusion on obviousness. We then either affirm the trial court if we agree with its conclusion, reverse if we do not, or vacate and remand for new or additional findings if, in our view, the record lacks facts essential to formulating a conclusion.

Claims

Neither the District Court nor the Court of Appeals for the Federal Circuit considered the claims of the Martin patent.

For the District Court and the Court of Appeals for the Federal Circuit to ignore the claims of the Martin patent is untenable. Claims in a patent are a requirement of 35

U.S.C. § 112 (supra page 5) and they are the heart of the patent. In the case of Sjolund v. Musland, 6 USPQ2d 2020 (Fed. Cir. 1988), the Court of Appeals for the Federal Circuit considered the claims of the patent involved in the suit at considerable length. The Court stated at the middle of column 2 on page USPQ2d 2027 (emphasis partially supplied):

> When claim construction is required, claims are construable, as above indicated, in light of the specification, United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966), yet "[t]hat claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims." Raytheon Co. v. Roper Corp., 724 F.2d at 957, 220 USPQ at 597.

The decision of the Court of Appeals for the Federal Circuit in the present case made reference only to the specification and not the claims stating (emphasis supplied):

> . . . when Martin is construed in light of the specification it is clear that there are significant differences between the Gibson and Martin devices.

The Sjolund v. Musland decision of the Court of Appeals for the Federal Circuit then continued (emphasis supplied):

> If everything in the specification were required to be read into the claims, or if structural claims were limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor . . . would a basis remain for the statutory necessity that an applicant conclude his specification with "claims particularly pointing out and distinctly claiming the subject matter which the applicant

> regards as his invention." 35 U.S.C. § 112.

The Court then emphasized (emphasis partially supplied):

> It is the claims that measure the invention. SRI International, 775 F.2d at 1121, 227 USPQ at 585. As our opinion in SRI makes clear, the claims define the invention.

In view of this ruling of the Court of Appeals for the Federal Circuit in the Sjolund v. Musland decision, how could that very court disregard the claims of the Martin patent in its decision in this case?

The dissenting opinion in the present case stated (APPENDIX C, page 9a, middle):

> It is the claims of the Martin patent which provide the concise, operative definition of the invention and, therefore, it is to the words of the claims that we must look to determine the scope of the patented invention. Autogiro

Co. of America v. United States, 384 F.2d 391, 395-96, 155 USPQ 697, 701 (Ct. Cl. 1967).

Court's Interpretation of Prior Art

In the present case the trial court did not discuss the prior art at all. The Court of Appeals for the Federal Circuit stated the proper procedure to be followed by that court under such circumstances in Kimberly-Clark Corporation v. Johnson & Johnson and Personal Products Company, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984), at the middle of column 1 on page USPQ 610:

> Since the trial court's opinion lacks a comparison of the invention of Roeder's claims with the prior art, we have made it ourselves . . . .

This procedure is in accord with decisions by the Court of Appeals for

the 7th Circuit to the same effect as follows:

The Taylor-Reed Corporation v. Mennen Food Products, Inc., et al., 324 F.2d 108, 139 USPQ 143, 145 (7th Cir. 1963) (emphasis supplied):

> The district court made a number of findings of fact contrary to the conclusion we have reached. Since we are able to resolve this question on the basis of documentary evidence, the findings of the district court on this issue are deprived of the degree of finality which would otherwise attach under Rule 152(a), Federal Rules of Civil Procedure, 28 U.S.C.A. Kiwi Coders Corporation v. Acro Tool & Die Works, 7 Cir., 250 F.2d 562, 568, 116 USPQ 2, 6 (1958), and cases cited therein. The documentary rule stated in Kiwi Coders was cited with approval in Nicholson v. Carl W. Mullis Engineering and Mfg. Co., 4 Cir., 315 F.2d 532, 536, 137 USPQ 13, 16 (1963). See, Becker v. Webcor, Inc., 7 Cir., 289 F.2d 357 361, 129 USPQ 111, 114 (1961), cert. denied, 368 U.S. 970, 132 USPQ 703; Armour & Co. v. Wilson & Co., 7 Cir., 274 F.2d 143, 152, 124 USPQ 115, 121-122 (1960). We hold, therefore, that such contrary

findings on this proposition must be set aside.

Nasco Incorporated v. Vision-Wrap, Inc., 352 F.2d 905, 147 USPQ 297, 299 (7th Cir. 1965) (emphasis supplied):

> The defendant offered no testimony, expert or otherwise, on the prior patent art. The appealed decision rests entirely on documentary evidence and physical exhibits. Consequently, the court's findings, in so far as they concern the use made of prior art, the nature of the improvement made over prior art, and the operational functions and characteristics of the patented structure and the accused device, are deprived of the degree of finality which would otherwise attach under Rules 52(a) of the Federal rules of Civil Procedure (28 U.S.C.A.). We are in as good a position as the trial court to examine and evaluate the evidence and make the necessary determinations ourselves. Charles Peckat Mfg. Co. v. Jacobs, 7 Cir., 178 F.2d 794, 802, 84 USPQ 4, 11; Kiwi Coders Corporation v. Acro Tool & Die Works, 7 Cir., 250 F.2d 562, 568, 116 USPQ 2, 6; Armour & Co. v. Wilson & Co., 7 Cir., 274 F.2d 143, 151-157, 124 USPQ

115, 121-126; and Welsh Co. v. Chernivsky, 7 Cir., 342 F.2d 586, 588, 144 USPQ 288, 290.

The case of Dennison Manufacturing Company v. Panduit Corp., 106 US 1578, 229 USPQ 478 (Sup. Ct. 1986) held that the Court of appeals for the Federal Circuit must consider Rule 52(a) of the Federal Rules of Civil Procedure, but in the present case the District Court made no findings of fact but simply ultimate conclusions of law. Consequently, Rule 52(a) does not apply to this case despite the reference of the Court of Appeals for the Federal Circuit to the case of Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

The Lindemann Decision

In the present case, the District Court made no finding of fact bearing either on the issue of anticipation (35 U.S.C. § 102) or on the issue of obviousness (35 U.S.C. § 103). In the Lindemann decision on the other hand, the District Court made 60 findings of fact (221 USPQ at page 484, column 1, bottom, and column 2, middle). Recognizing the "clearly erroneous" standard of Fed.R.Civ.P. 52(a), the court stated at the middle of column 1 on page 485:

> However salutary, the rules governing review do not envision an appellate court shirking its duty to reverse an appealed judgment that is clearly based on legal error and unsupported by evidence in the record.
> . . .
> . . . the language in an opinion, or in a set of findings and conclusions, may

> indicate that numerous harmful errors of law produced an erroneous conclusion . . . .

The court further explained the duty of an appellate court which was not followed by a majority of the court in the present instance, as follows at 221 USPQ at page 485, top of column 2 (emphasis supplied):

> In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference.

In the Lindemann case also, the trial court, as well as the Court of Appeals for the Federal Circuit, considered the issue of obviousness at 221 USPQ page 486, column 1, in connection with which the appellate court stated at

221 USPQ page 487, column 2, top (emphasis supplied):

> . . . the district court stated that it had considered the facts in light of the inquiries mandated by Graham v. John Deere & Co., 383 U.S. 1, 148 USPQ 459 (1966) . . . .

The Court of Appeals for the Federal Circuit did not follow suit in the present case.

Obviousness is a Matter of Law

As stated by the Court of Appeals for the Federal Circuit in In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988) at page 1598, top of column 2:

> . . . an obviousness determination is not reviewed under the clearly erroneous standard applicable to fact findings, Raytheon Co. v. Roper Corp., 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983); it is "reviewed for correctness or error as a matter of law." In re De Blauwe, 736 F.2d 699,

703, 222 USPQ 191, 195 (Fed. Cir. 1984).

It is respectfully submitted that since the question of obviousness is one of law and there was only documentary evidence in the case, the Court of Appeals for the Federal Circuit should have followed the decisions discussed above and made its own determination as to the validity of claim 1 of the Martin patent based by applying the documentary evidence to the wording of that claim in accordance with the third requirement of the statute 35 U.S.C. § 103 as to obviousness.

CONCLUSION

For the reasons discussed above, the judgment of the United States Court of Appeals for the

Federal Circuit should be vacated and this case should be remanded to that court for further consideration in light of the following decisions:

Graham v. John Deere Co. of Kansas City et al., 383 US 1, 148 USPQ 459 (Sup. Ct. 1966);

Sjolund v. Musland, 6 USPQ2d 2020 (Fed. Cir. 1988);

Kimberly-Clark Corporation v. Johnson & Johnson and Personal Products Company, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984).

The decision of Novicky v. Syntex Opthalmics, 225 USPQ 792 (Sup. Ct. 1985) stated:

> The petition for a writ of certiorari is granted. The judgment is vacated and the case is remanded to the United States Court of Appeals for the Federal Circuit for further consideration in light of Marrese v. American Academy of

Orthopaedic Surgeons, 470 U.S. -- (1985). Justice Powell took no part in the consideration or decision of this case.
Opinion below: 223 USPQ 695.

DATED this 21st day of October, 1988.

Respectfully submitted,

Robert W. Beach

Robert W. Beach
Attorney for Petitioner

3107 Eastlake Ave E
Seattle, WA 98102
(206) 325-6789

APPENDIX NO. 1

TABLE OF CONTENTS

PAGE

APPENDIX A:
Order of the United States District Court for the Western District of Washington on motions for summary judgment dated June 10, 1986 in Civil suit No. C83-824T. 1a

APPENDIX B:
Decision of the Court of Appeals for the Federal Circuit decided July 1, 1988 in appeal No. 88-1174. . . . . 4a

APPENDIX C:
Dissenting opinion of decision of the Court of Appeals for the Federal Circuit decided July 1, 1988 in appeal No. 88-1174 . . . . . 7a

APPENDIX D:
Denial of Petition for Rehearing by the Court of Appeals for the Federal Circuit dated July 28, 1988 . . 18a

APPENDIX E:
Denial of Suggestion for Rehearing in Banc dated August 11, 1988 . . . . . 20a

IN THE UNITED STATES
DISTRICT COURT
FOR THE WESTERN DISTRICT
OF WASHINGTON
AT TACOMA

GRAVITY GUIDANCE, INC.,	)	
	)	
Plaintiff,	)	No.
	)	C83-824T
vs.	)	Entered
	)	Order
ROGER TEETER and	)	Docket
JENNIFER TEETER, d/b/a	)	June 10,
SKY'S THE LIMIT.	)	1986
Defendant.	)	By Deputy

THIS MATTER comes on before the above-entitled Court upon the following motions: Plaintiff's Motion for Partial Summary Judgment on the issue of patent infringement, and Defendants' Motion for Partial Summary Judgment on the issue of the validity of the patent in suit.

Having considered the entirety of the records and file herein, and

having heard oral argument of counsel, the Court finds and rules as follows:

1. Regarding the motions for partial summary judgment, there are no genuine issues of material fact and judgment may be made as a matter of law.

2. Defendants did not literally infringe upon Plaintiff's patent rights.

3. Under the Doctrine of Equivalents, Defendants infringed upon the patent rights of Plaintiff.

4. The infringement of Defendants was willful.

5. The patent rights asserted by Plaintiff are valid.

Accordingly, it is hereby

ORDERED that Plaintiff's Motion

for Partial Summary Judgment is GRANTED; and it is further

ORDERED that Defendants' Motion for Partial Summary Judgment is DENIED.

The clerk of the court is instructed to send uncertified copies of this Order to all counsel of record.

DATED this 10th day of JUNE 1986.

/s/ Jack E. Tanner
UNITED STATES DISTRICT JUDGE

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

88-1174

GRAVITY GUIDANCE, INC.,

Plaintiff-Appellee,

v.

ROGER TEETER and JENNIFER TEETER d/b/a SKY'S THE LIMIT,

Defendants-Appellants.

DECIDED: July 1, 1988

Before ARCHER, MAYER, and MICHEL, Circuit Judges.

PER CURIAM.

DECISION

The decision of the United States District Court for the Western

District of Washington, No. C83-824T (W.D. Wash. 1986), on cross-motions for partial summary judgment holding plaintiff's patent valid and infringed, is affirmed.

OPINION

Our review of the record convinces us that the district court did not err in its determination that (1) there were no genuine issues of material fact, (2) the 3,380,447 (Martin) patent had not been shown to be invalid, and (3) Teeter had willfully infringed the Martin patent. Teeter's primary argument on appeal is that the claimed invention is anticipated by the 2,209,310 (Gibson) patent. But a patent is presumed

valid, see 35 U.S.C. § 282, and when Martin is construed in light of the specification it is clear that there are significant differences between the Gibson and Martin devices. Accordingly, the district court correctly determined that Teeter had failed to carry its burden to establish anticipation. See, e.g., Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Circ. 1984) (Anticipation is a factual determination which is reviewed under the clearly erroneous standard).

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

88-1174

GRAVITY GUIDANCE, INC.,

Plaintiff-Appellee,

v.

ROGER TEETER and JENNIFER TEETER d/b/a SKY'S THE LIMIT,

Defendants-Appellants.

MICHEL, Circuit Judge, dissenting.

In its grant of summary judgment, the district court simply stated that "[t]he patent rights asserted by Plaintiff are valid." This conclusion the majority affirms solely on the ground that the Teeters

failed to carry their burden to establish anticipation of the Martin claims by the prior art Gibson patent. I am not convinced, however, that the sole issue on appeal with respect to validity was anticipation. The appellants did make the basic argument that, if the courts which had previously considered the Martin patent had had Gibson before them in addition to the previously-cited prior art, the Martin patent would have been found invalid. To me this is necessarily an obviousness argument. Furthermore, in my view, Gibson, together with the previously-cited prior art, is more than enough to render the claimed invention obvious to one of ordinary skill in the art.

Even if I confine my views on validity to the issue of anticipation, I do not agree with the majority that the differences between Gibson and the claims of Martin are "significant" and can be used to distinguish Martin as patentable. Rather, it appears to me that for each feature recited in the first (and only independent) claim of Martin there exists corresponding structure in Gibson.

It is the claims of the Martin patent which provide the concise, operative definition of the invention and, therefore, it is to the words of the claims that we must look to determine the scope of the patented invention. Autogiro Co. of America v. United States, 384 F.2d 391, 395-96, 155 USPQ 697, 701 (Ct. Cl. 1967).

Particular limitations or embodiments appearing in the specification should not be read into the claims, Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 867, 228 USPQ 90, 93 (Fed. Cir. 1985), although the descriptive portion of the patent specification can properly be relied upon to aid in an interpretation of the terms contained in the claims. Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 452, 227 USPQ 293, 296 (Fed. Cir. 1985). Moreover, claim interpretation is a question of law, and this court need not defer to the district court under standards appropriate to factual determinations. Loctite, 781 F.2d at 866, 228 USPQ at 93. Accordingly, only differences which relate to the limitations stated in the claims, as

those limitations are properly interpreted, can be used to determine whether legally significant differences exist between Gibson and Martin.

The appellee basically concedes structural identify of its boot with the Gibson device, but argues, relying on the preamble of claim 1 and the patent specification, that its boot pertains specifically to "inversion" or "hanging" and thus is distinguishable from Gibson. The preamble of Martin's first claim recites: "In a device of the class described, an inversion boot . . . ." The claims proceed to describe the structure of the Martin boot. Appellee thus asserts that the denomination of the Martin structure

as an "inversion boot" means that the claimed structure is an ankle device for use in "hanging a person from an inverted position from a horizontal bar." However, Martin's first claim does not mention "inversion" as uniquely accomplished by "hanging." Moreover, Gibson also discloses a device which, although not said to be for "hanging," nonetheless acts to place a set of forces on the body which are "inverse" to those normally applied by gravity to the body while standing.

Had this been the first time that this patent was subjected to judicial review, it might be proper to find that Gibson does not anticipate Martin by interpreting the term "inversion" in the patent claims by

reference to the specification's limitation of "inversion" to "hanging" upside down, in contrast to the general "inversion" of the direction of the usual forces of gravity on the body as shown by Gibson. However, the litigation history of the Martin patent shows that it would be improper to incorporate "hanging" as used in the specification into the "inversion" limitation contained in the claim of Martin.

In prior litigation involving the Martin patent, it was specifically determined that Martin had claimed a specific ankle boot structure and that the "hanging" aspect emphasized by the appellee here was not viewed as significant. For example, in one prior suit (in which Gibson was not

cited as prior art) it was observed that:

> Plaintiff, however, is not claiming to have patented the idea of hanging upside down and such would be ridiculous since "obviously anyone knows that you can suspend yourself upside down by taking a rope and tying it to a higher object." Martin v. Wittmer, No. 82-71298, 220 USPQ 24 (E.D. Mich. 1982). Rather, plaintiff has patented a means of hanging upside down. (emphasis in original)
>
> The prior art submitted by defendants shows that the concept of treating back problems by inversion is not a unique method of treatment. The same prior art shows, however, that plaintiff's ankle holders, a device to achieve the inversion, are unique and nonobviousness [sic] as a means of treatment.

Gravity Guidance, Inc. v. Weseman, 220 USPQ 953, 957 (D. Minn. 1983) (portion of magistrate's report on validity as adopted by the district court, 220 USPQ 1038, 1040 (D. Minn. 1983)).

Confronted in the earlier suits with the prior art which disclosed "hanging" but not their disclosed structure, appellee conceded that the prior art disclosed "hanging" but argued that its invention should be distinguished from that "hanging" art on the basis of unique structure. Now, confronted with newly-discovered prior art which discloses its structure, the appellee argues that its claims are limited to that structure as used solely for "hanging." In my view, the appellee should not be allowed to benefit from such inconsistent arguments, but should be bound both by prior rulings on limitations and present concessions on identity of structure.

Furthermore, a defendant is not precluded from attempting to show invalidity of a patent simply because that patent has not been shown invalid in prior suits, Allen Archery, INc. v. Browning Manufacturing Co., 819 F.2d 1087, 1091, 2 USPQ 2d 1490, 1492-93 (Fed. Circ. 1987), especially when newly-discovered prior art not at issue in the prior suits is presented. Stevenson v. Sears, Roebuck & Co., 713 F.2d 705, 711 n.5, 218 USPQ 969, 974 n.5 (Fed. Cir. 1983).

Under the foregoing view of how the claims of Martin, as a matter of law, should have been interpreted, it appears quite clear that appellants produced a previously uncited reference which, unlike the references cited during prosecution or prior

litigation of the Martin patent, disclosed all of the structure set forth in the claims. In my opinion, Gibson anticipates Martin and the court below should have so found. I would reverse the district court on the issue of validity; therefore, I dissent.

Note: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

88-1174

GRAVITY GUIDANCE, INC.,

Plaintiff-Appellee,

v.

ROGER TEETER and JENNIFER TEETER
d/b/a SKY'S THE LIMIT,

Defendants-Appellants.

Before ARCHER, MAYER, and MICHEL, Circuit Judges.

O R D E R

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for

rehearing be, and the same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

FOR THE COURT:

7/28/88 /S/
Date Francis X. Gindhart, Clerk

cc: Mr. Robert W. Beach
Mr. Bruce W. McKee

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
July 28, 1988
Francis X. Gindhart
Clerk

Note: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

88-1174

GRAVITY GUIDANCE, INC.,

Plaintiff-Appellee,

v.

ROGER TEETER and JENNIFER TEETER
d/b/a SKY'S THE LIMIT,

Defendants-Appellants.

O R D E R

A suggestion for rehearing in banc having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the suggestion for rehearing in banc is declined.

FOR THE COURT:

8/11/88 /S/
Date Francis X. Gindhart, Clerk

cc: Mr. Robert W. Beach
Mr. Bruce W. McKee

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
August 11, 1988
Francis X. Gindhart
Clerk